

Claims 14-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,626,382 to Johnson (hereinafter “*Johnson*”) in view of U.S. Patent No. 5,274,846 to Kolsky (hereinafter “*Kolsky*”). Claims 14-20 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of U.S. Patent No. 4,270,228 to Gaiser (hereinafter “*Gaiser*”). Applicants respectfully traverse these rejections.

The law is clear that a patent is to be granted unless the Patent Office can establish that the invention would have been obvious at the time it was made. Here, the Examiner has failed to meet this burden in at least two ways:

1. The suggestion for combining Johnson with *Kolsky* is absent; and
2. The suggestion for combining Johnson with *Gaiser* is absent.

Additionally, among other things, the Examiner’s specific rejection of claims 16 and 18 are improper.

A. The Examiner Has Not Established The Requisite Motivation To Combine Johnson With *Kolsky*

The Examiner acknowledges that neither *Johnson* nor *Kolsky*, alone, discloses, teach or suggest the present invention. The Examiner stated “*Johnson* fails to teach a plastic pad comprising both non-impregnable and impregnable layers. *Kolsky* rectifies the deficiencies. *Kolsky* teaches in an analogous art, a cushion comprising a non-impregnable layer 14 bonded to an impregnable layer 18 (Fig. 1). . . . One of ordinary skill in the art of automotive interiors would go to the art of cushion . . . for guidance on how to make a composite pad” Applicants respectfully disagree with this assertion.

There is no motivation in the prior art to combine *Johnson* with *Kolsky*. The law requires that there be some teaching, suggestion, or motivation to combine *Johnson* with *Kolsky*. In *In Re Anita Dembischak and Benson Zinbarg*, 50 USQP2d 1614 (Fed. Cir. 1999),

the CFAC indicated that the requirements for showing the teaching or motivation to combine references is "rigorous." *Id.* at 1617. Moreover, this showing must be "clear and particular." *Id.* It is well-established that merely because references can be combined does not provide the motivation for such a combination. *Berghauser v. Dann, Comr. Pats.*, 204 USPQ 398 (D.C.D.C. 1979); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929 (Fed. Cir. 1984). A mere conclusory statement supporting the proposed combination does not satisfy the rigorous requirement that evidence of motivation for combination be clear and particular. *McElmurry v. Arkansas Power & Light Co.*, 27 USQP2d 1129, 1131 (Fed. Cir. 1993).

Here, the requisite motivation to combine the references in the prior art is not present. *Johnson*, which pertains to injection molded plastic automobile door panels having an integral localized soft-touch aesthetic feature is silent on the use of a composite pad such as that disclosed by *Kolsky*. On the contrary, *Johnson* speaks only of an "elastomeric plastic pad or flexible-foam pad." Consequently, an artisan of ordinary skill reviewing the invention of *Johnson* would not have been taught by *Johnson* to substitute a composite pad for the elastomeric plastic pad or flexible-foam pad disclosed in *Johnson*. Similarly, there is no teaching in *Kolsky* which suggests that the multi-layered cushion of *Kolsky* can be incorporated into automotive door panels. On the contrary, *Kolsky* provides an exhaustive list of applications for the multi-layered cushion:

A cushion, pad, or mat in accordance with the present invention has a broad range of uses including knee pads and shin guards, exercise mats, beach pads, stadium seat cushions, wheelchair cushions, and bathtub liners. In addition, the cushion may be used in luggage handles and pads for shoulder straps. The multi-layer cushion material may also be used as a liner material for gloves, for example, as padding in a baseball glove or along the fingers of a glove.

See Kolsky, col. 3, ll. 19-27.

Although automobile door panels have existed and have been cushioned since well before June 12, 1990 (the original application date for *Kolsky*), there is no mention in *Kolsky* of the use of his cushion in conjunction with such molded door panels.

Applicants believe that the only "motivation" for combining these references to support the Examiner's rejection is impermissible hindsight. The CAFC has spoken several times on this issue, which occurs frequently, but which is forbidden by law.

If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements, would permit an Examiner to use the claimed invention as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'

In Re Rouffet, 37 USPQ2d 1453, 1456 (Fed. Cir. 1998), quoting *Sensonics, Inc. v. Aerasonic Corp.*, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

As the CAFC stated in *In Re Rouffet*, it is improper for an Examiner to use the subject application as the blueprint for piecing together prior art which contains each element of the claimed combination. This appears to be the case here, however. This conclusion is supported by the Examiner's failure to cite to any language in either *Johnson* or *Kolsky* which teaches that these two references can be combined.

Further supporting the conclusion that Applicants' claimed combination is not obvious over *Johnson* in view of *Kolsky* is the fact that *Johnson* and *Kolsky* come from non-analogous arts. Whether prior art is analogous is a two-fold determination. *In Re Wood*, 202 USPQ 171, 174 (C.C. Pa. 1979). First, it must be determined if the prior art reference is within the field of the Applicants' endeavor. *Id.* If it is not, then it must be determined whether the prior art reference is reasonably pertinent to the specific problem that the Applicants sought to solve. *Id.* Here, neither prong is satisfied.

Johnson relates to molded plastic door panels for use in automobiles. *Kolsky*, on the other hand, relates to cushioning material for use as padding in sporting goods. As such, *Johnson* and *Kolsky* come from two totally different fields of endeavor. Thus, the only way *Kolsky* could be considered analogous is if *Kolsky* is reasonably pertinent to the specific problem that Applicants sought to solve. As explained in greater detail below, *Kolsky* is not.

Johnson and *Kolsky* also sought to solve two totally different problems. Applicants seek to solve the problem of how to make an injection molded door panel having an integral pad positioned in between the panel's substrate and cover material such that the pad is not dislodged during the molding process. *Kolsky*, on the other hand, sought to solve the problem of how best to distribute the energy created by impact in body protection devices such as kneepads and shoulder pads. One seeking to solve the problem of how to incorporate a pad into an injection molded plastic door panel during the injection molding process would be unconcerned with the problem of how to absorb and distribute the energy associated with the impact of solid objects. Similarly, one seeking to solve the problem of how to absorb and distribute the impact energy of solid objects would be unconcerned with the problem of how to manufacture an injection molded plastic door panel having an integral soft pad.

Because *Johnson* and *Kolsky* come from two totally different fields of endeavor and because *Johnson* and *Kolsky* solve problems which are unrelated to one another, *Johnson* and *Kolsky* are non-analogous. The combination of elements from non-analogous sources, in a manner that reconstructs the Applicants' invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. *In Re Oetiker*, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992). There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. *Id.* As discussed above, there is no such reason, suggestion or motivation. Because that motivation cannot come from the Applicants' invention itself, the Examiner's combination of *Johnson* with *Kolsky* was inappropriate and does not render Applicants' invention obvious.

Furthermore, it appears that the Examiner misunderstood the objective of the Applicants' invention. The Examiner stated "one of ordinary skill in the art of automotive interiors would go to the art of cushion . . . for guidance on how to make a composite pad because there is a teaching in Kolsky . . . of solving a problem associated with air circulation and moisture resistance to retain the natural lightness of the composite pad which is the concern of the present invention." The Examiner has misstated the "concern of the present invention." Applicants are not concerned with air circulation or moisture resistance. Nor are Applicants concerned with retaining the "natural lightness of the composite pad." Instead, as set forth on pages 2 and 3 of the application, Applicants are concerned with manufacturing an injection molded door panel having an integral cushion where the cushion allows molten plastic resin to flow through the impregnable portion of the cushion during the molding process without dislodging the cushion, thus making it unnecessary to bond the cushion to the door panel cover material prior to inserting that material into the mold. Neither *Johnson* nor *Kolsky* address this concern. As discussed on pages 2 and 3, Applicants discovered that using a composite pad that has an impregnable layer and a non-impregnable layer addresses this concern. There is no teaching in the prior art to use such a composite pad in an injection molded door panel.

Furthermore, even if Applicants were concerned with "solving a problem associated with air circulation and moisture resistance to retain the natural lightness of the composite pad," neither *Johnson* nor *Kolsky* address this concern. The Applicants have thoroughly reviewed *Kolsky* and has been unable to find any reference or suggestion that it is concerned with air circulation or moisture resistance.

Accordingly, the combination of *Johnson* with *Kolsky* is improper and the rejection should be withdrawn.

B. The Examiner Has Not Established The Requisite Motivation To Combine *Johnson* With *Gaiser*

The Examiner acknowledges that Neither *Johnson* nor *Gaiser*, alone, disclose, teach or suggest the present invention. The Examiner stated "Johnson fails to teach a plastic

pad comprising both non-impregnable and impregnable layers. . . . Gaiser discloses a hand cover wherein the back surface of the hand cover is of non-reticulated foam integrally formed with a pad of reticulated foam (claim 8). One of ordinary skill in the art of automotive interiors would go to the art of . . . making the hand cover for guidance on how to make a composite pad" Applicants respectfully disagree with this assertion.

As set forth above, the law requires that there be some teaching, suggestion, or motivation to combine *Johnson* with *Gaiser*. In *In Re Anita Dembischak and Benson Zinbarg*, 50 USPQ2d 1614 (Fed. Cir. 1999), the CAFC indicated that the requirements for showing the teaching or motivation to combine references is "rigorous." *Id.* at 1617. This showing must be "clear and particular." *Id.* Merely because references can be combined does not provide the motivation for such a combination. *Berghauser v. Dann, Comr. Pats.*, 204 USPQ 398 (D.C. D.C. 1979); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 228 USPQ 929 (Fed. Cir. 1984). Conclusory statements supporting the proposed combination do not satisfy the rigorous requirement that evidence of motivation or combination be clear and particular. *McElmurry v. Arkansas Power & Light Co.*, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993.)

The requisite motivation to combine *Johnson* with *Gaiser* is simply not present. *Johnson* pertains to injection molded plastic automobile door panels having an integral localized soft touch aesthetic feature. *Gaiser*, on the other hand, pertains to an improved glove, the external surface of which is coated with a reticulated foam which improves the ability of a person wearing such a glove to grip objects such as tools, bats, racquets, and the like in wet conditions. There is no teaching in *Johnson* which suggests the use of the glove of *Gaiser*. The Examiner admits as much by failing to cite any language in *Johnson* supporting such a combination. Similarly, there is no teaching in *Gaiser* which suggests that the claimed hand cover can be incorporated into automotive door panels. On the contrary, *Gaiser* explicitly stated the problems he sought to solve. None of them relate to automotive door panels:

A difficulty with covering handles of tools and the like is that the coverings are not readily or immediately removable and, in addition, a large number of objects are not adaptable to covering with sheet material. To illustrate, wet ropes, fish and watermelon are all difficult to grasp when wet and are not adaptable to covering with the reticulated foam.

See Gaiser, col. 1, ll. 27-34.

Applicants believe that the only "motivation" for combining these references to support the Examiner's rejection is impermissible hindsight. As set forth in Section A, above, the CAFC has spoken unambiguously on this subject and has forbidden an Examiner to use the subject application as the blueprint for piecing together prior art which contains each element of the claimed combination. This appears to be what the Examiner has done here. This conclusion is supported by the Examiner's failure to cite any language in either *Johnson* or *Gaiser* which teaches that these two references can be combined.

Further support for the conclusion that Applicants' claimed combination is not obvious over *Johnson* in view of *Gaiser* is the fact that *Johnson* and *Gaiser* come from non-analogous arts. Whether prior art is analogous is a two-fold determination. *In Re Wood*, 202 USPQ 171, 174 (C.C. Pa. 1979). First, it must be determined if the prior art reference is within the field of the Applicants' endeavor. *Id.* If it is not, then it must be determined whether the prior art reference is reasonably pertinent to the specific problem that the Applicants sought to solve. *Id.* Here, neither prong is satisfied.

Johnson relates to molded plastic door panels for use in automobiles. *Gaiser*, on the other hand, relates to an improved glove which allows the person wearing that glove to grip slippery objects in wet conditions. Injection molded door panels and items of apparel come from two totally different fields of endeavor. Thus, the first prong is not satisfied.

Applicants and *Gaiser* also sought to solve two totally different and unrelated problems. Applicants seek to solve the problem of how to make a plastic injection molded automotive door panel having an integral pad positioned in between the panel's substrate and

cover material such that the pad is not dislodged during the molding process. *Gaiser*, on the other hand, sought to solve the problem of how to make a glove capable of maintaining the wearer's grip on objects which are wet. One seeking to solve the problem of how to incorporate a pad into a plastic injection molded automotive door panel during the injection molding process would be unconcerned with the problem of how to make a glove capable of maintaining its grip under wet conditions. Similarly, one seeking to solve the problem of how to make a glove retain its grip while wet would be unconcerned with the problem of how to manufacture an injection molded plastic door panel having an integral soft pad.

Because *Johnson* and *Gaiser* come from two totally different fields of endeavor and because *Johnson* and *Gaiser* solve problems which are unrelated to one another, *Johnson* and *Gaiser* are non-analogous. The combination of elements from non-analogous sources, in a manner that reconstructs the Applicants' invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. *In Re Oetiker*, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992). There must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. *Id.* As discussed above, there is no such reason, suggestion or motivation. Because that motivation cannot come from the Applicants' invention itself, the Examiner's combination of *Johnson* with *Gaiser* was inappropriate and does not render Applicants' invention obvious. Accordingly, the rejection based on the combination of *Johnson* with *Gaiser* should be withdrawn.

C. The Examiner's Rejection Of Claims 16, 17 And 18 Are Improper And Must Be Withdrawn

Regarding the rejection of claims 16, 17, and 18, Applicants contend that they are allowable due to their dependency on claim 14.

With respect to the Examiner's rejection of claim 16, the Examiner correctly points out that *Kolsky* "does not specify the pore distribution or the foam density." (April 9, 2002 Office Action, p. 3.) The Examiner also admits that *Gaiser* does not disclose

the pores per inch range specified by claim 16 of 1 to 100 and a foam density of about 1.5 to 2.5 pcf. (The Examiner states "Gaiser discloses the foam having a 10 to 100 pores per inch (col. 3, l. 45) and being no greater than 10 volume percent (col. 4, ll. 68 *et seq.*)" (April 9, 2002 Office Action, p. 3.))

Despite *Gaiser's* failure to disclose each element of claim 16, the Examiner states that it would have been obvious to one having ordinary skill in the art to have altered the range of the pore distribution and the range of foam density of the impregnable layer and that Applicants have merely discovered the optimum or workable ranges for this invention. However, as set forth above, the Examiner cannot establish a *prima facie* case of obviousness based on *Gaiser* because there is no motivation to combine it with *Johnson* and because it is from a non-analogous art which solves an entirely different problem. Consequently, one seeking to solve the problem solved by the present invention would never look to *Gaiser*.

Additionally, the Examiner appears to have misunderstood the object of the present invention. The Examiner states on pages 3 and 4 of the April 9, 2002 Office Action that "it would have been obvious to the skilled artisan [sic] to have optimized the range of the pore distribution and the range of the foam density of the impregnable layer motivated by the desire to permit free air circulation so that the pad readily breaths in use and moisture is expelled rather than retained, thereby retaining its natural lightness." However, Applicants' invention was not motivated by a desire to permit free air circulation around the pad or to allow the pad to breath in use or to expel moisture, thereby retaining its "natural lightness." On the contrary, Applicants claim a composite pad having a portion made of reticulated material to allow molten plastic resin to flow through the reticulated material without dislodging the composite pad and to ultimately harden within the reticulated material thereby retaining the composite pad in its proper position on the door panel. Because the present invention has a completely different objective than that of *Gaiser*, the pores per inch and foam density specified in claim 16 cannot be obvious in view of *Gaiser*.

With respect to the Examiner's rejection of claim 18, the Examiner incorrectly characterizes claim 18 as a "product by process" claim. It is not. Applicants have amended

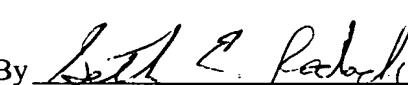
claim 18 to more specifically and particularly point out the claimed invention. Claim 18 now reads: "the substrate of claim 17 wherein at least portions of the rigid substrate is present throughout the impregnable layer." Neither *Johnson* nor *Kolsky* nor *Gaiser*, nor any combination of the three, discloses this claimed invention. Furthermore, because there is no motivation to combine these references, as discussed in sub-sections A and B above, neither *Johnson*, in combination with *Kolsky*, nor *Johnson* in combination with *Gaiser*, render this claimed invention obvious.

Applicants submit that the claims are now in a condition for allowance and respectfully request a notice to that effect.

A check in the amount of \$ 110.00 is enclosed to cover the Petition fee. Please charge any additional fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978 — a duplicate of this paper is enclosed for that purpose.

Respectfully submitted,

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Attachment

AUG 14 2002

S/N: 09/612,369

Atty Dkt No. FMCV 0113 PUS

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In The Claims

14. (Amended) An automobile interior molded panel comprising;
a rigid substrate;
a composite pad comprising a non-impregnable layer and an impregnable layer;
and
a cover skin disposed over and bonded to the substrate and the pad.

18. (Amended) The [substrate] panel of claim 17 wherein at least portions of the rigid substrate is [formed] present throughout the impregnable layer [upon solidification of the resin].